

**REMARKS**

**I. Status of the Claims**

Applicant submits this Amendment in reply to the final Office Action dated February 4, 2009. Claims 1-3, 7, 8, 13, 15-17, 23, 28, 9, 32-37, 40, 41, 44, 48, 49, 51, 53-57, 60, 61, and 72-90 are the pending, non-withdrawn claims in this case, with claims 1, 40, 72, and 84 being independent. By this Amendment, Applicant has amended claims 1, 18, 24, 40, 42, 43, 46, 58, 59, 72, and 84, canceled claims 32, 35, 53, and 60, without prejudice or disclaimer, and added new claims 91-94. The originally-filed specification, claims, abstract, and drawings fully support the subject matter of the amended and new claims, and no new matter has been entered.

In the Office Action, claims 72-74, 83, 84, and 89-90 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,364,355 to Alden et al. ("Alden"). In addition, claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 32-37, 40, 41, 44, 48, 49, 51, 53-57, 60, 61, and 72-90 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,299,630 to Yamamoto ("Yamamoto") in view of U.S. Patent No. 2,587,707 to Dever ("Dever") and Alden. In so far as the Examiner deems these rejections to apply to the claims as amended, Applicant respectfully traverses for at least the following reasons.

**II. Rejection Under 35 U.S.C. § 102(b)**

Independent claims 72 and 84 each recites, among other things, a medical device including a handle, an end effector assembly, an elongate, flexible member

connecting the handle to the end effector assembly, and a groove defined by the handle, wherein the groove “houses each of the loops and the end effector assembly” (claim 72) or the groove “accommodates a first portion of the elongate member and a portion of the end effector assembly” (claim 84).

Applicant respectfully traverses the Section 102 rejection of independent claims 72 and 84. For anticipation, each and every feature recited in a claim must be found in one item of prior art, either expressly or inherently, and arranged in the item of prior art in the same way as it is claimed. See MPEP 2131 (“The elements must be arranged as required by the claim, ... In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990.”). That is, the identical invention must be shown in as complete detail as is contained in the claim. See, e.g., Brown v. 3M, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (“To anticipate, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim.”) Richardson v. Suzuki Motor Co., Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

In this case, no embodiment of *Alden* discloses a device defined in claims 72 and 84. For example, *Alden* fails to teach or suggest a device including a groove that “houses each of the loops and the end effector assembly” (claim 72) or a groove that “accommodates a first portion of the elongate member and a portion of the end effector assembly” (claim 84). In rejecting claims 72 and 84, the Office Action points to Figs. 1-3 of *Alden* and appears to rely on adapter 17 as allegedly corresponding to the claimed handle, dilation balloon 13 as allegedly corresponding to the claimed end effector

assembly, guidewire 14 as allegedly corresponding to the claimed elongate member, and slit 23 as allegedly corresponding to the claimed groove. (Office Action at p. 3.)

Even assuming the Office Action's characterizations of *Alden* are correct, a point which Applicant does not concede, *Alden* fails to disclose or suggest that slit 23 houses (or accommodates) dilation balloon 13.

*Alden* therefore does not anticipate claims 72 and 84, and Applicant respectfully requests withdrawal of the Section 102 rejection of these claims based on *Alden*.

Each of claims 73-74, 83, and 89-90 depends directly from either independent claim 72 or 84 and is patentable for at least the same reasons. In addition, the dependent claims recite unique combinations that are neither taught nor suggested by the cited reference, and therefore also are separately patentable for these recitations.

### **III. Rejection Under 35 U.S.C. § 103(a)**

Independent claims 1 and 40 each recites, among other things, a medical device comprising a handle including a plurality of grooves, an end effector assembly, and an elongate member. At least one groove "accommodates a portion of the end effector assembly" (claim 1), or "a portion of the elongate member and a portion of the end effector assembly is disposed in at least one groove" (claim 40).

Independent claims 72 and 84, each recites, among other things, a medical device including a handle, an end effector assembly, an elongate, flexible member connecting the handle to the end effector assembly, and a groove defined by the handle, wherein the groove "houses each of the loops and the end effector assembly"

(claim 72) or the groove “accommodates a first portion of the elongate member and a portion of the end effector assembly” (claim 84).

Each independent claim therefore requires at least a portion of an end effector assembly to be housed, disposed, or accommodated in a groove.

In rejecting independent claims 1, 40, 72, and 84, the Office Action admits that *Yamamoto* “discloses the invention substantially as claimed except for the slider or spool further comprises grooves on the distal portion, proximal portion and the central portion.” (Office Action at p. 4.) The Office Action then relies on *Dever* and *Alden* for their alleged teachings of a spool including a plurality of grooves. (Office Action at p. 5.) Even assuming the Office Action’s characterizations are correct, which Applicant does not concede, *Dever* and *Alden* fail to cure the deficiencies of *Yamamoto*. As described above, slit 23 of *Alden* does not house or accommodate dilation balloon 23. Moreover, the electrical plug is not housed, accommodated, or disposed in slots 29, 30 of *Dever*. *Dever* and *Alden* therefore fail to disclose or suggest that at least one groove “accommodates a portion of the end effector assembly” (claim 1), or “a portion of the elongate member and a portion of the end effector assembly is disposed in at least one groove” (claim 40). Moreover, *Dever* and *Alden* fail to disclose or suggest that a groove “houses each of the loops and the end effector assembly” (claim 72) or that a groove “accommodates a first portion of the elongate member and a portion of the end effector assembly” (claim 84).

Furthermore, the Office Action fails to address the analogous art arguments of the October 22, 2008 Reply to Office Action. Applicant maintains that *Dever* does not constitute analogous art.

*Dever* discloses an electric cord storage device which is non-analogous to the art of medical devices. According to the M.P.E.P., a reference in a field different from that of an Applicant's invention, used as a basis for rejection, "may be reasonably pertinent if it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his or her invention as a whole." M.P.E.P., § 2141.01(a)(I) *citing KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1397 (2007). Here, an inventor seeking to solve problems with safe packaging, unwrapping, and disposal of a medical instrument would not have turned to the art of electric cord storage.

A fundamental difference between an elongate member of, for example, a long endoscopic medical instrument and an electric cord is that the elongate member typically has resilient or springy properties and cannot be tightly wound. These properties make it difficult to package the elongate member in a tightly wrapped arrangement and can cause the elongate member to whip, or spring, open when unpackaged or being prepared for disposal. Additionally, the distal tip of the elongate member typically includes a medical tool which may be sharp and/or require sterility. Thus, packaging and unwrapping of the medical instrument may further require that the distal tip of the elongate member be packaged or housed to prevent contact with objects and surfaces of its external environment for safety and sterility purposes. A typical

electric cord, on the other hand, does not have such properties (e.g. a springy nature, an inability to be tightly wound, or a sharp tip requiring no contact with an unsterile environment). Therefore, the problems or difficulties encountered for the safe packaging, unwrapping, and disposal of a medical instrument are significantly different than the problems associated with concealing and storing an electric cord in a neat and ornamental appearance. For example, and as shown in Figs. 1 and 2 of *Dever*, electric cord 13 is tightly wound around core 15 of storage spool 11, with the electrical plug freely extending from spool 11. However, a typical elongate member of a medical instrument would not be capable of being in a tightly wound arrangement for packaging purposes as the resilient and springy properties of the elongate member would cause unwinding and unraveling of the elongate member and potential unsafe and unsanitary contact of the distal tip with its external environment. Moreover, having the end effector unpackaged and allowed to move freely would create potential unsafe and unsanitary conditions.

Thus, one of ordinary skill in the art of medical devices would not have looked to the art of electrical cord storage devices to remedy the problems associated with the safe packaging, unwrapping, and disposal of medical instruments, as the storage techniques suited for the properties of electric cords would not be appropriate for medical instruments. Accordingly, the rejection is improper because the art of electrical cord storage devices is not analogous to the art of medical instruments and reconsideration is respectfully requested.

Dependent claims 2-3, 7-8, 13, 15-17, 23, 28, 29, 33, 34, 36, 37, 41, 44, 48, 49, 51, 54-57, 61, 73-83, and 85-90 depend either directly or indirectly from either independent claim 1, 40, 72, or 84 and are allowable over *Yamamoto*, *Dever*, and *Alden* at least due to their dependence on either independent claim 1, 40, 72, or 84.

#### IV. New Claims

New independent claim 91 recites, among other things, a medical device comprising a handle, an end effector assembly, and an elongate, flexible member. The handle includes a spool portion, the spool portion including a proximal portion and a distal portion connected by a central portion, wherein a first plurality of grooves are arranged along an outer circumference of the proximal portion and a second plurality of grooves are arranged along an outer circumference of the distal portion. The grooves of the first plurality of grooves are “separated from each other along the outer circumference of the proximal portion,” and the grooves of the second plurality of grooves are “separated from each other along the outer circumference of the distal portion, and at least one of the first and second plurality of grooves houses the plurality of loops.” At least these claimed features are neither disclosed nor suggested by *Yamamoto*, *Dever*, and *Alden*. For example, and as shown in Figs. 1-3 of *Alden*, slit 23 (allegedly corresponding to the claimed plurality of grooves) include adjoining serrations. Moreover, each serra<sup>n</sup> merely houses a single turn 19 of guidewire 14.

Although of different scope than independent claim 91, dependent claims 93 and 94 patentable distinguish from *Yamamoto*, *Dever*, and *Alden* for at least the same reasons.

Moreover, *Yamamoto*, *Dever*, and *Alden* fail to disclose or suggest that "at least one of the first and second plurality of grooves houses the end effector assembly," as recited in claim 92.

**V. Conclusion**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered, placing claims 1-3, 7, 8, 13, 15-17, 23, 28, 29, 33, 34, 36, 37, 40, 41, 44, 48, 49, 51, 54-57, 61, and 72-94 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 18, 24, 40, 42, 43, 46, 58, 59, 72, and 84 and new claims 91-94 do not necessitate the undertaking of any additional search of the art. Therefore, this Amendment should allow for immediate action.

Applicant respectfully points out that the final action presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance. Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the patentability of the pending claims be disputed.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art

Customer No. 22,852  
Application No.: 10/808,427  
Attorney Docket No. 06530.0314-00000

references cited against this application. Applicant therefore requests the entry of this Amendment, reconsideration, and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 27, 2009

By: \_\_\_\_\_

  
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